

# REMARKS

## I. ALLOWABLE SUBJECT MATTER

Claims 18 and 25 to 26 were rejected as dependent on a rejected base claim, but were found to be allowable when rewritten in independent form including all the limitations of the base claim and any intervening claim according to the statement on page 3 of the final Office Action.

Dependent composition claim 18 has been amended so that it includes the limitations of independent composition claim 13 and is now an independent claim and thus should be allowed.

Dependent method claim 25 has been amended so that it includes the limitations of the independent method claim 22 and is now an independent method claim. Thus the amended claim 25 should be allowed.

Dependent claim 26 depends on the amended independent claim 25 and thus should also be allowed.

## II. NEW DEPENDENT CLAIMS

New dependent claims 30 to 33 have been added. New dependent claims 30 and 31 claim compositions with active ingredients with preferred peptidic

linker molecules that have especially good binding action to keratin-containing material, such as hair. New dependent claims 32 and 33 claim methods of performing cosmetic treatments with the preferred compositions of dependent claims 30 and 31.

Basis for the preferred compositions and methods according to new claims 30 and 32 is found in the second full paragraph on page 5 and in the paragraph that runs from page 5 to page 6 of applicants' originally filed specification. Similarly basis for the preferred compositions and methods according to new claims 31 and 33 is found in the first six lines of page 16 of the applicants' originally filed specification.

### **III. ANTICIPATION REJECTION**

Claims 13 to 17, 19 to 24, and 27 to 29 were rejected as anticipated under 35 U.S.C. 102 (a) by Masato Yoshioka, et al (JP 2003-104847 – referred to as JP '847 in the following remarks). The basis for the rejection is the provided English translation of JP '847)

#### **1. JP '847 is not a valid Prior Art Reference**

JP '847 has a publication date of April 9, 2003 according to the English translation of this JP reference, which is only about a month earlier than the effective filing date of the above-identified U.S. National Stage application,

namely May 14, 2003, the filing date of the PCT application. However the claims of the U.S. National Stage application are entitled to the benefit of the priority date of the German Priority document, namely 102 27 238.7 filed June 18, 2002 in Germany. This filing date of this DE priority document is almost a year earlier than the publication date of JP '847, which is thus not a valid reference that can be used to reject the claims of the present U.S. national stage application.

A certified English translation of 102 27 238.7 will be filed in order to perfect the claim of priority of invention so that the above-mentioned claims are entitled to the benefit of the priority date, namely June 18, 2002. The certified English translation of DE '238.7 will be filed as soon as it is obtained from our translator.

## 2. JP '847 would not Anticipate Applicants' Claims

Claims 13 and 22 are patentably distinguishable from the disclosures in JP '847.

JP '847 does disclose a cosmetic composition that improves combability, imparts moistness and has hair setting power according to [0008] on page 6 of the English translation of JP '847. The active ingredient in their cosmetic composition is a substituted polysiloxane compound that is covalently linked to a peptide group, which comprises a plurality of amino acid groups according to [0009]. The polysiloxane group provides the cosmetic treatment action. There are almost no limits regarding the nature of the peptide group: it can be natural

synthetic or hydrolyzed or derivatized according to [0016]. Many different silicon compounds can be applied in this manner according to [0020]. Standard cosmetic auxiliary ingredients for use in the composition are disclosed in [0034].

JP '847 teaches that their active ingredient compounds improve the water solubility of the silicon compound to which the peptide is attached and also problems involved in the preparation of the substituted polysiloxane compound that is covalently linked to a peptide group. See paragraphs [0007] and [0002] of the English translation.

However JP '847 does **not** disclose or suggest that the disclosed active ingredient compounds can **bind or can covalently attach to** keratin-containing material, particularly human hair.

Specifically claim 13 contains the following wording that further limitations the peptidic linker group of their active ingredients:

“said at least one peptidic linker having binding specificity for said keratin-containing material or being able to act as a binding agent for binding to said keratin-containing material”.

Claim 22 contains similar wording. The foregoing wording limits the peptidic linker group to groups that have the ability to covalently bond to the hair protein. All peptide groups formed from amino acids and derivatives of amino acids would not covalently bond to hair protein, for example a peptide that is formed from amino acid derivatives with a large number of hydrophobic groups. Furthermore different peptide groups would bond to hair protein with different bond strengths.

Applicants explain in the first paragraph on page 7 of their specification that finding peptidic linker molecules that covalently bond to keratin-containing

material is within the abilities of those of ordinary skill in the chemical arts.

Furthermore large numbers of different peptides are available in peptide libraries produced for use in molecular biology or genomics research, which may be screened by combinatorial methods.

Further preferred peptidic linker groups are disclosed on pages 5 and 6 and page 16 of applicants' specification. New dependent claims 30 to 33 claim compositions and methods limited to these preferred linker groups.

It is well established that each and every limitation of a claimed invention must be disclosed in a single prior art reference in order to be able to reject the claimed invention under 35 U.S.C. 102 (b) based on the disclosures in the single prior art reference. See M.P.E.P. 2131 and also the opinion in *In re Bond*, 15 U.S.P.Q. 2nd 1566 (Fed. Cir. 1990).

JP '847 does not limit the peptide group of the active ingredient compound to a group that has binding specificity for keratin-containing material, specifically hair protein, or that can covalently bond to hair protein.

For the foregoing reasons withdrawal of the rejection of claims 13 to 17, 19 to 24, and 27 to 29 as anticipated under 35 U.S.C. 102 (a) by Masato Yoshioka, et al, JP '847, is respectfully requested.

Furthermore it is respectfully submitted that new claims 30 to 33 should **not** be rejected under 35 U.S.C. 102 (a) by Masato Yoshioka, et al (JP 2003-104847).

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects to put this case in condition for final allowance, then it is requested that such amendments or corrections be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing the case to allowance, he or she is invited to telephone the undersigned at 1-631-549 4700.

In view of the foregoing, favorable allowance is respectfully solicited.

Respectfully submitted,

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